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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/530,308	09/05/2000	Shih-fu Chang	A31358-PCT	5406
21003	7590	10/20/2005		EXAMINER
BAKER & BOTTS				DESIR, JEAN WICEL
30 ROCKEFELLER PLAZA				
NEW YORK, NY 10112			ART UNIT	PAPER NUMBER
			2614	

DATE MAILED: 10/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/530,308	CHANG ET AL.	
	Examiner	Art Unit	
	Jean W. Désir	2614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 7/11/05, BRIEF ON APPEAL.

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-5 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) Claim(s) _____ is/are allowed.
6) Claim(s) 1-5 is/are rejected.
7) Claim(s) _____ is/are objected to.
8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date

4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ .

5) Notice of Informal Patent Application (PTO-152)

6) Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 2 are rejected under 35 U.S.C. 102(b) as being anticipated by Braudaway et al (US 5,530,759).

Claim 1:

Braudaway discloses:

“obtaining digital data of a transformed representation of the image”, see Fig. 2 item 202;

“determining a transformed representation of the watermark for optimized visibility of the watermark in the image”, see Fig. 2 items 206, 214, ABSTRACT lines 1-3;

“and superposing the transformed representation of the watermark on the transformed representation of the image”, see Fig. 2 items 214, 215, ABSTRACT lines 1-3.

Claim 2 is disclosed, because of the subtracting and clipping operation that happened in items 206, 212 of Fig. 2.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tewfik et al (US 6,031,914).

Claim 1:

Tewfik discloses:

"obtaining digital data of a transformed representation of the image", see Fig. 4 items 36, 38, col. 1 lines 31-40;

"determining a transformed representation of the watermark for optimized visibility of the watermark in the image", see Fig. 4 item 42;

"and superposing the transformed representation of the watermark on the transformed representation of the image", see Fig. 4 item adder sign, col. 7 lines 36-38.

The **only** difference between the claimed invention and Tewfik is that Tewfik does not explicitly teach "**optimized**" the visibility of the watermark in the image. However, Tewfik suggests a visible watermark (see col. 7 lines 49-52); thus, optimized the visibility of the watermark in the image, as claimed, is at level of one of ordinary skill in the art in view Tewfik's disclosure, because Tewfik teaches or suggests visible watermark as pointed out above. Therefore, the claimed invention would have been obvious to a person of ordinary skill in the art at the time the invention was made.

Claim 2 is disclosed, Fig. 4 items 36, 38.

Claim 3 is disclosed, see Fig. 4 item 38 (DCT or Discrete Cosine Transformed representation as claimed).

Claim 4 is disclosed, see Fig. 4 item 36, col. 1 lines 31-40.

5. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tewfik et al (US 6,031,914) in view of Girod et al (US 5,809,139).

Claim 5:

Tewfik does not explicitly say that the transformed representation includes **motion compensation** as claimed in claim 5. However, transformed representation that includes **motion compensation** is a notoriously well known technique in the art (as evidence see Girod at Figs. 1, 1A items 10, MC, which is a transformed representation (10) that includes motion compensation (MC)) used in image compression to reduce redundancy; thus, an artisan would be motivated to modify Tewfik and implement this existing technique to arrive at the claimed invention, because it is readily available to the designer and better compression ratios would be obtained by employing this technique to reduce redundancy. Therefore, the claimed invention would have been obvious to a person of ordinary skill in the art at the time the invention was made.

Response to Arguments

6. Applicant's arguments have been fully considered but they are not persuasive.

Applicants argue on page 6 of the BRIEF ON APPEAL that "In contrast, the method claim 1 determines optimal visibility of the transform coefficients of the

watermark directly based on the transform coefficients of the images *without decoding of transform coefficients of the image*. Nothing in Braudaway discloses or suggests such a technique. The claimed method for determining optimal visibility of the transform coefficients of the watermark is different from the method described by Braudaway".

These arguments are not persuasive, because the subject matter as claimed in claim 1 recited "determining a transformed representation of the watermark for optimized visibility of the watermark in the image" and this claimed subject matter is clearly disclosed by Braudaway as pointed out in the rejection. Applicants argue limitations that are not in the claims, for instance the subject matter "*without decoding of transform coefficients of the image*" and "transform coefficients of the watermark" are not in the claim, as emphasized by the Applicants. These arguments are not persuasive because the specification is not the measure of invention. Therefore, limitations contained therein can not be read into the claims for the purpose of avoiding the prior art. See *In re Sporck*, 55 CCPA 743, 386 F.2d 924, 155 USPQ 687 (1968).

Applicant's arguments regarding the other claims are moot in view of the new ground of rejections.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jean W. Désir whose telephone number is (571) 272 7344. The examiner can normally be reached on 5/4/9 - First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Miller can be reached on (571) 272 7353. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JWD
Oct. 6, 05



JOHN MILLER
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